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Assistant Commissioner for Patents
Washington, D. C. 20231

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02/07/02

A Certificate of U.S. EXPRESS Mailing by article ET658228994US is attached to this response.

Re: Patent Application of Brad A. Armstrong

Serial No.: 09/721,848 Filed: 11/22/2000

Title: SHEET CONNECTED SENSORS WITH VIBRATION

Applicant's mailing address: Brad A. Armstrong
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Paradise, CA 95967

Examiner: Chow, Doon Y
Group Art Unit: 2675

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Technology Center 2600

IN RESPONSE TO THE EXAMINER'S COMMUNICATION DATE MAILED 12/05/01

Dear Sir:
REMARKS

This is in response to the Office Action mailed 12/05/01 regarding my above specified patent application. Would the Examiner please amend my application as herein requested. After entering the amendments, please reexamine the application as amended in view of the herein remarks favoring allowance, finding all claims allowable. Thank you.

Included herewith is an additional written Information Disclosure Statement and listing forms (PTO-1449) and copies of the listed disclosures for consideration by the Examiner. The \$180.00 small entity fee payment is also included.

The fee payment of \$249.00 for the extra claims is also herewith included.

The Office Action Summary has been read. It is noted claims 1-25 as filed on Nov. 22, 2000 are pending. The instant application is believed to be serial 09/721,848 as listed on the

Office Action Summary, and not the serial 09/522,787 typed at the tops of pages 2-6 of the Office Action. Please let Applicant know if this is not the case.

The acknowledgement of the Information Disclosure Statements of papers 1 and 2 sent by Applicant is appreciated.

Regarding page 2 and point 1 of the Office Action: The quotation of 35 USC 103(a) has been read.

Regarding pages 2-5 of the Office Action: This has been carefully read. Regarding the 35 USC 103 rejection of the claims 1-20 in over Chandler (4,246,452) in view of Culver (6,256,011), and in the case of claims 1, 2, 4, 7, 19-20, further in view of Applicant's Figure 38 embodiment: The initial rejection of these claims is very respectfully disagreed with by Applicant. Applicant cannot find in the writing in any column or line in either Chandler or Culver any suggesting that features thereof be combined as suggested by the Examiner. The Examiner is combining features from various disclosures (Chandler and Culver) to simulate the claimed invention based upon hindsight gained from a reading of Applicant's specification and not teachings or suggestions actually present in the prior art disclosures. The Court of Appeals for the Federal Circuit (CAFC) has reiterated the proscription of the Patent and Trademark Office aggregating references in the absence of a teaching or suggestion supporting the combination. The Court of Appeals has specifically required that teachings of references are properly combined only if there is some suggestion or incentive in the prior art to do so. Thus, as brought out in *ACS Hospital Systems v. Montefiore Hospital*, 221 USPQ 929,933:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the

combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. The prior art of record fails to provide any such suggestion or incentive. Accordingly, we hold that the court below erred as a matter of law in concluding that the claimed invention would have been obvious to one of ordinary skill in the art under section 103.

Again the Court of Appeals for the Federal Circuit considered the question of aggregation of references in connection with a court appeal in *Panduit Corporation v. Dennison Manufacturing Co.*, 227 USPQ 337, and reiterated the requirement that the prior art must provide either a teaching or a suggestion of the claimed invention in order to provide a proper basis for rejection of claims under 35 U.S.C. 103 by the Patent Office.

The Examiner in the present case is combining or aggregating the references on the basis of hindsight he has gained from reading Applicant's disclosure. The CAFC, in the *Panduit Corporation* decision, specifically negated such use of subjective hindsight in determining the question of Sec. 103 obviousness:

"This court and one of its predecessors have cautioned against the use of hindsight:

It is difficult but necessary that the decision maker forget what he or she has been taught at trial about the claimed invention and case the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art who is presented only with the references, then-accepted wisdom in the art. *W. L. Gore & Associates., Inc. v. Garlock, Inc.* U, 721 F. 2d. at 1553, 220 USPQ at 313.

It is impermissible to first ascertain factually what appellants did and then view

the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct appellants' invention from such prior art. In re Shuman, 361 F. 2d 1008,1012, 150 USPQ 54,57 (CCPA 1966)."

The Examiner is combining these references herein only in view of the hindsight he has gained by reading Applicant's disclosure. The CAFC, in the Panduit Corp. case, has specifically required that, in resolving the question of nonobviousness, the Examiner must consider each and all of the references in their entirety as to whether there is any suggestion therein of the combination claimed.

In applying the hindsight of the Examiner's knowledge of applicant's disclosure, the Examiner has neglected to consider the portions of the references which argue against obviousness of the present claims. The relied upon prior art teaches away from Applicant's invention rather than suggesting Applicant's invention, as clearly, for example only, Culver could have applied the input member, buttons and sheet of the then 20 year old Chandler switch apparatus to his device, but Culver did not. By failing to acknowledge such teachings away, the Examiner is failing to follow the mandates of the CAFC.

The Patent Office policy is clearly to follow these mandates. Thus, in the decision of the Patent and Trademark Office Board of Patent Appeals and Interferences, Ex parte Clapp, 227 USPQ 972, the Board specifically followed the mandate by requiring that either the references must expressly or impliedly suggest the claimed combination, or the Examiner must present a clear and convincing line of reasoning as to why an artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

The Board more particularly concurred with the CAFC that it is improper for an Examiner to selectively pick and choose elements or concepts from various references to arrive at a

claimed invention by using hindsight gained from his knowledge of Applicant's claims as a guide. Thus, where, as in the present case, the Examiner cites references respectively showing different elements but completely barren of any teaching or suggestion in the references that they be combined in the manner of the claims, such aggregation of references does not properly support a rejection of the claims.

The claims will be amended below to more clearly define the invention. Additional remarks favoring allowance of claims will follow amendments to the claims so that the remarks may be directed to the claims as amended. Thank you.